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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/577,083

12/08/2006

Claus Permesang

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EXAMINER

LAUX, JESSICA L

ART UNIT

PAPER NUMBER

3635

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/577,083	<b>Applicant(s)</b> PERMESANG, CLAUS	
	<b>Examiner</b> JESSICA LAUX	<b>Art Unit</b> 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/24/2006</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 recites the limitation "the bordering". There is insufficient antecedent basis for this limitation in the claim. The claim will be examined as best understood.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; specifically the phrase "in particular" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites "devices for connecting" and depending claim 11 recites "connector devices". It is unclear if the connector devices of claim 11 are the same as or different than the devices for connecting of claim 1. For examination purposes it has been understood that they are the same. Appropriate correction is required.

Additionally, the phrase "particularly for..." renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the phrase "particularly" renders the claim indefinite because it is unclear whether the limitations preceding/following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 20 recites the limitation "the flexible building component". There is insufficient antecedent basis for this limitation in the claim. Claim 19 recites a flexible building system and claim 1 recites a building component but neither of the preceding claims provides support for a flexible building component. The claim will be examined as best understood.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-11, 13-17, 19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Fowler (20040031225).**

Claims 1, 3-6, 19-21. Fowler discloses a flexible building system having building component for forming floor and/or wall coverings comprising a support layer (16) and a layer which is connected to the support layer, a floor and/or wall forming layer made of at least one coating element (17, 18, 19) as well as elastic devices (20, 22) for connecting similar building components applied to a floor or a wall.

It should be noted that claims 3-5 are considered a product-by-process claim. The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985). In the instant case the adhesive is capable of being foamed or sprayed in any manner on the support layer and the coating element.

Claim 2 (as best understood). The building component according to claim 1, characterized in that wherein the support layer is connected by means of an intermediate layer (the chemical adhesive of paragraph 0020, and 60) to the at least one coating element (17, 18,19).

Claim 7. The building component according to claim 2, wherein the intermediate layer is made of an elastic and/or water-resistant material (paragraphs 0032, 0058).

Claim 8 (as best understood). The building component according claim 1, wherein the support layer is made of recycling material, in particular of plastic recycling material (paragraph 0021).

Claim 9. The building component according to claim 1, wherein the coating element is made of ceramic, stoneware, natural stone, glass, plastic, metal and/or wood (paragraphs 0023-0024).

Claim 10. The building component according to claim 1, wherein the elements for forming the devices (20,22) for connection of the building components are molded

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together to the intermediate layer in one piece and/or the intermediate layer is foamed or sprayed on separate similar elements (as seen in the figures (paragraphs 0032-0058)).

Claim 11 (as best understood). The building component according to at claim 1, wherein the building component comprises connector devices (20, 22), particularly for tongue-and-groove joints.

Claim 13. A building component according to claim 10, wherein engaging connector devices are provided (as seen in figures 2-3).

Claim 14. The building component according to claim 11, wherein the groove is formed between the support layer and the layer encompassing the coating element (as seen in the figures).

Claim 15. The building component according to claim 10, wherein the edges of the support layer and of the layer encompassing the coating element are arranged offset relative to each other, parallel to the plane of the support layer (as seen in figure 2).

Claim 16. The building component according to claim 10, wherein an element having the tongue or groove is connected in one piece with the intermediate layer (as seen in figures 2-3).

Claim 17. The building component according to claim 1, wherein the support layer has a surface profile (as seen in the figures).

Claim 22. The building component according to claim 1, wherein the building component is curved as a whole and/or exhibits a curved surface (at 23).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler (20040031225) in view of Miller (2003020980).**

Claim 12. Fowler discloses the building component according to claim 11, where a tongue is formed opposite a groove, however Fowler does not disclose that a groove is tongue and groove are formed at two sides respectively. Rather Fowler discloses that a tongue and groove are formed at one side.

Miller discloses a building component having layers and a tongue formed opposite a groove, where the groove is at two adjacent perpendicular sides and the tongues are opposite the grooves (figure1).

At the time the invention was made it would have been obvious to one having ordinary skill in the art to modify the component of Fowler to have two perpendicular sides with a groove and the opposite sides with a tongue to improve the connection between adjacent placed building components.

**Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler (20040031225) in view of Milborn (2548036).**

Claim 18. Fowler discloses the building component according to claim 1, but does not disclose pipes for a heating and/or cooling, heating conductors and/or sensors are embedded in the building component, particularly in the support layer.

Milborn discloses a panel for use in flooring having layers and pipes for heating a floor made of the panels (see figures; disclosure).

At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the panel of Fowler to have the pipes as disclosed by Milborn to incorporate heating/cooling into the building component to provide efficient and space-saving thermal elements to a building.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA LAUX whose telephone number is (571)272-8228. The examiner can normally be reached on Monday thru Thursday, 9:00am to 5:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard E. Chilcot, Jr./  
Supervisory Patent Examiner, Art Unit 3635

/J. L./  
Examiner, Art Unit 3635